

REMARKS

In the Office Action dated November 28, 2005, claims 1-6 and 8-11 were presented for examination, claims 5, 6, and 11 were withdrawn from consideration, and claim 10 was canceled. Claim 6 was rejected under 35 U.S.C. §112, second paragraph. Claim 1 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Morgan*, U.S. Patent No. 4,301,919, in view of *Mayer*, U.S. Patent No. 5,667,248 and *Hillemann et al.*, U.S. Patent Publication No. 2003/0211268. Claims 2-4 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Morgan* '919 in view of *Hillemann et al.* '268.

The following remarks are provided in support of the pending claims and responsive to the Office Action of November 28, 2005 for the pending application.

I. Rejection of Claim 6 under 35 U.S.C. §112

In the Office Action dated November 28, 2005, claim 6 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. More specifically, the Examiner raised an issue with misdescriptive matter on lines 5 and 6. Applicants has amended claim 6 to clarify this language and to remove the misdescriptive elements therein. Accordingly, Applicants respectfully request that the Examiner remove the rejection of claim 6 under 35 U.S.C. §112, second paragraph.

II. Rejection of Claim 1 under 35 U.S.C. §103(a)

In the Office Action dated November 28, 2005, claim 1 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Morgan* '919 in view of *Mayer* '248 and *Hillemann et al.* '268.

Morgan '919 pertains to a kit for returning a lost or stolen wallet through postal service, or courier. The kit of *Morgan* '919 includes a card with indicia to convey usage and shipping instructions, a holder to receive the card, stamp, and an adhesive to seal the card to the holder so that the card remains in the holder.

Mayer '248 pertains to a greeting card that contains one or more messages thereon, wherein portions of these messages may be concealed with a detachable cover. At such time as someone wants the messages revealed, the detachable cover or covers may be removed. Similarly, the covers may be replaced over the revealed indicia to remove the visibility of the message.

The *Hillemann et al.* '268 publication pertains to a resealable envelope. As shown the envelope includes a flap with an adhesive attached thereto. The adhesive portion enables the flap to be secured to a front section of the envelope, in essence sealing an opening of the envelope and an items stored therein.

Applicants have amended claim 1 to further more positively recite the patentable aspects of the invention. More specifically, Applicant has amended in language pertaining to securing the holder to a secondary surface. Support for the amended language is found on Page 13, line 12 of the original specification. As such, claim 1 requires that the prior art references teach, use, or selection of indicia and a holder, applying the indicia to the holder, selecting a display source for the holder, inserting the combined indicia and holder into a pocket of the display, manipulating a reusable flap tab, and securing the flap tab to a secondary surface. None of *Morgan* '919, *Mayer* '248, and *Hillemann et al.* '268 has a teaching, suggestion, or use of a an adhesive attached to a flap portion to enable the flap to secure the holder to a secondary surface. Only *Mayer* '248 and *Hillemann et al.* '268 teach a reuseable adhesive. However, neither of these references teach use of the adhesive for securing the holder in its entirety to a secondary surface. In order to apply the reuseable adhesive of *Mayer* '248 or *Hillemann et al.* '268 would require a modification to these patent in such a way not anticipated nor envisioned in either *Mayer* '248 or *Hillemann et al.* '268. Such a modification goes against the teaching of both *Mayer* '248 and *Hillemann et al.* '268. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP §2143.03 (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). Furthermore, "Although a prior art device may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." MPEP §2143.01 (citing *In re Mills*, 916 F.2d 680, 682, 16 USPQ 2d. 1430 (Fed. Cir. 1990)). Neither *Mayer* '248

nor *Hillemann et al.* '268 suggest use of a reuseable adhesive to secure the holder to a secondary surface that is independent of and separate from the body of the holder. To read either *Mayer* '2481 or *Hillemann et al.* '268 as providing a reuseable adhesive to an appendage of the holder body would require a modification to the inventions of *Morgan* '919, *Mayer* '248, and *Hillemann et al.* '268 not envisioned or required in their respective apparatus. Accordingly, Applicant respectfully contends that the teachings of *Morgan* '919, *Mayer* '248, and *Hillemann et al.* '268 do not meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests the Examiner remove the rejection of claim 1.

III. Rejection of Claims 2-4 and 8 under 35 U.S.C. §103(a)

In the Office Action dated November 28, 2005, claims 2-4 and 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Morgan* '919 in view of *Hillemann et al.* '268.

The remarks pertaining to both *Morgan* '919 and *Hillemann et al.* '268 above are hereby incorporated by reference.

Claims 2-4 and 8 are apparatus claims pertaining to the structure of Applicant's invention. Applicants have amended claims 2 and 8 to recite the tab and associate flap structure. More specifically, each of claims 2 and 8 positively recite an adhesive material applied to the tab and how removal of the flap from the surface of the tab enables the display unit to be secured to a secondary surface. As discussed above with respect to claim 1, none of the prior art references teach, suggest, or motivate one of ordinary skill in the art to apply an adhesive to a display unit or a surface in communication with the display unit to enable the display unit to be secured to a secondary surface. Based upon the original disclosure, claims 1, 2 and 8 have each been amended to more specifically recite the elements associated with temporarily securing the display unit to a secondary surface. More specifically, claims 1, 2, and 8 as amended each recite a flap in communication with the adhesive surface, and the two positions of the flap in relation to the adhesive surface.

Neither *Morgan* '919 nor *Hillemann et al.* '268 teach use of a display unit with an adhesive on a surface of a tab portion and a resealable enclosure associated with the tab portion. Even if Applicants were to apply the reuseable adhesive of *Morgan* '919 or *Hillemann et al.* '268, the combination of these two references still do not include the tab portion with an adhesive and the tab associated flap. This combination of references would require a modification to these patents in such a way not anticipated nor envisioned in either *Morgan* '919 or *Hillemann et al.* '268. Such a modification goes against the teaching of both *Morgan* '919 and *Hillemann et al.* '268. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP §2143.03 (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). Furthermore, "Although a prior art device may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." MPEP §2143.01 (citing *In re Mills*, 916 F.2d 680, 682, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Neither *Morgan* '919 nor *Hillemann et al.* '268 suggest use of a reuseable adhesive to secure the holder to a secondary surface that is independent of and separate from the body of the holder. Furthermore, neither of these prior art references teach, suggest, or provide motivation for a flap associated with tab portion that houses the adhesive surface to expose or cover the adhesive surface. To read either *Morgan* '919 or *Hillemann et al.* '268 as providing a reuseable adhesive to an appendage of the holder body would require a modification to the inventions of *Morgan* '919 and *Hillemann et al.* '268 not envisioned or required in their respective apparatus. Accordingly, Applicant respectfully contends that the teachings of *Morgan* '919 and *Hillemann et al.* '268 do not meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests the Examiner remove the rejection of claim 2-4 and 8.

IV. Conclusion

Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Accordingly, Applicant requests that the Examiner indicate allowability of claims 1-4 and 8-10, and that the application pass to issue. If the Examiner believes, for any reason, that personal communication

will expedite prosecution of the application, the Examiner is hereby invited to telephone the undersigned at the number provided.

For the reasons outlined above, withdrawal of the rejection of record and an allowance of this application are respectfully requested.

Respectfully submitted,

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Date: April 28, 2006